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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

50277-1725

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on July 31, 2006

Signature

Typed or printed name Angelica Maloney

Application Number

10/091,618

Filed

March 4, 2002

First Named Inventor

Sashikanth Chandrasekaran

Art Unit

2168

Examiner

Harold E. Dodds

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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July 31, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 6 forms are submitted.

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REMARKS

THE OFFICE ACTION FAILS TO PRESENT A PRIMA FACIE CASE OF OBVIOUSNESS UNDER 35 U.S.C. § 103(a) AS A MATTER OF LAW

35 U.S.C. § 103(a) states:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the **subject matter sought to be patented** and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains” (emphasis added).

Thus, as a matter of law, to present a prima facie case of obviousness under 35 U.S.C. § 103(a), the differences between the subject matter sought to be patented and the prior art must be such that the **subject matter sought to be patented as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The Patent Office has long recognized that a proper rejection based on 35 U.S.C. § 103(a) must allege that the subject matter sought to be patented as a whole must be disclosed or taught by the prior art. MPEP § 2106, II, C states:

[W]hen evaluating the scope of a claim, **every** limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements **in isolation**. Instead, the claims as a whole must be considered. (emphasis in original)

Thus, to establish a prima facie case of obviousness as a matter of law, the claimed limitations, as a whole, must be alleged to be taught or suggested by the prior art. Merely dissecting a claimed invention into discrete elements, and then evaluating the dissected elements in isolation fails to present a prime facie case of obviousness as a matter of law.

In violation of MPEP § 2106, II, C and 35 U.S.C. § 103(a), the Office Action not only divides each claim into its constituent elements, but also finely dissects each constituent

element into a set of short phrases and sentence fragments. The Office Action then points out how each individual fragment corresponds to a similar fragment in any one of a handful of references. The fragment-to-prior-art correlation appears to have been made without any consideration as to the relationship between the fragments, the meaning of the elements as a whole, and the meaning of the claim as a whole.

None of the nine cited references have been cited to disclose, teach, or suggest the subject matter of any element of any of the independent claims. Instead, the Office Action dissects the claimed elements into discrete elements and then evaluates the dissected elements in isolation, rather than considering the elements as a whole. For example, no cited reference is alleged to show the subject matter of “sending the modified data item from said first node to a second node of said multiple caches without durably storing the modified data item from said first node to persistent storage.” Instead:

- Draper is cited to show “sending the modified data item from said first node to a second node of said multiple caches”
- Draper is cited to show “the modified data item from said first node”
- Draper is cited to show “to persistent storage,” and
- Bereznyi is cited to show “without durably storing.”

As stated in MPEP § 2106, II, C, **Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation.** It is respectfully submitted that, rather than alleging that the subject matter of “sending the modified data item from said first node to a second node of said multiple caches without durably storing the modified data item from said first node to persistent storage” is taught by any cited reference, the Office Action impermissibly dissects the claimed invention into discrete elements and then evaluates those elements in isolation.

Accordingly, it is submitted that the Office Action fails to present a prima facie case of obviousness under 35 U.S.C. § 103(a) as a matter of law. As a consequence, it is respectfully submitted that the rejection made to Claims 1-23 and 49-71 under 35 U.S.C. § 103(a) may not be properly maintained. Therefore, Applicants respectfully request either (a) an explanation as to why the **subject matter sought to be patented as a whole** in each of each of Claims 1-23 and 49-71 is obvious in view of the prior art, or (b) allowance of each of Claims 1-23 and 49-71 where an explanation as to why the **subject matter sought to be patented as a whole** is obvious in view of the prior art cannot be provided.